From: Trials
To: Bregman, Dion M.; PH-Lam-Inpria-IPR; Williamson, Amanda S.
Cc: Trials
Subject: RE: IPR2024-00033 / Stewart Deposition
Date: Friday, February 7, 2025 12:37:20 PM

Counsel,

The Board will issue an order in due course that addresses the request set forth in the email below. No conference call is necessary. The Board will enter a copy of this email correspondence as Exhibit 3011.

Regards,

Franchesca I. Alicea Villanueva
Supervisory Paralegal
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Bregman, Dion M. <dion.bregman@morganlewis.com>
Sent: Thursday, February 6, 2025 4:42 PM
To: Trials <Trials@USPTO.GOV>
Cc: PH-Lam-Inpria-IPR <PH-Lam-Inpria-IPR@paulhastings.com>; Williamson, Amanda S. <amanda.williamson@morganlewis.com>
Subject: IPR2024-00033 / Stewart Deposition

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Your Honors,

During the January 30 hearing, we had discussed that the district court had not yet ruled on the application for a subpoena to depose the third party declarant from ProQuest, Ms. Heather Stewart (we were told that the delay is because the judge was in trial). That application included a proposed subpoena with a deposition date of February 3—a date Ms. Stewart's counsel had indicated that she would be available.

The parties have met and conferred on this issue, and each side presents their position below.

Petitioner's Section:

Given this delay, and your Honors' request to get back to you with any requests for an extension, Petitioner respectfully requests that the Board extend the deadline for Ms. Stewart's deposition (previously set for **February 5**) to **February 21**, 2025. Additionally, we request that the Board extend the post-deposition briefing schedule by two weeks as follows:

1. No later than **March 5, 2025**, each party may file a supplemental brief, not to exceed five (5) pages in length, strictly limited to addressing the relevance of Ms. Stewart's deposition

testimony to the issue of whether Stowers 2008 qualifies as prior art against the challenged patent claims.

2. No later than **March 12, 2025**, each party may file a response to the opposing party's supplemental brief, not to exceed five (5) pages in length.
3. No later than **March 14, 2025**, the parties shall meet and confer to resolve whether the Board should conduct a telephonic conference to hear arguments on the supplemental briefs.
4. No later than **March 14, 2025**, the parties shall jointly file a paper, not to exceed one (1) page in length, indicating their joint position (or, if no joint position is reached, clearly and succinctly setting forth their respective positions) regarding such a conference.

This proposed schedule adjustment still allows the Board almost **six weeks** to issue a final written decision by **April 24, 2025**.

Regarding the district court, we intend to file an amended application with a renewed proposed subpoena with a new deposition date to be determined based on the court's ruling and Ms. Stewart's availability.

Furthermore, responding to PO's section below, during the hearing your honors authorized us to ask Ms. Stewart about any documents in her deposition including the new document that PO wants to introduce (the OSU packet), and introduce those documents as exhibits. We disagree with PO that the OSU packet should be filed alone without Ms. Stewart's testimony of what it is and means.

Thank you.

-Dion Bregman (Petitioner)

Patent Owner's Section:

Considering the Board has strictly prohibited the parties from presenting arguments in emails, Inpria is available for a teleconference to the extent the Board desires.

To the extent Lam insists to send this email with its positions anyway, to preserve Inpria's rights, Inpria notes that it disagrees with Lam's proposal in view of Lam's stated intention to introduce additional exhibits (that have not been disclosed to Inpria) through the deposition beyond the OSU packet (that was provided by OSU, not ProQuest or Ms. Stewart) that the Board has already authorized. Given the advanced stage and impending statutory deadline, Inpria believes the least prejudicial path forward is for the Board to authorize filing of the OSU packet for consideration as corroborative evidence, without introduction of further depositions/exhibits/briefing.

Respectfully,
-Michael Wolfe (Patent Owner)

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